

REMARKS

Claims 35-48 are pending in the above-entitled action. Claims 49-51 have been added by the foregoing amendment.

The Examiner rejected claims 35-48 under 35 U.S.C. § 103(a) as obvious over Applicants' admitted prior art in view of Oliver (U.S. Patent No. 2,031,384) and Harmala et. al. (U.S. Patent No. 5,320,386). The Applicants respectfully traverse the Examiner's rejection.

Section 2143 of the Manual of Patent Examining Procedure states that three basic criteria must be met for establishing a *prima facie* case of obviousness, stating:

First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations.

If the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Section 2142 MPEP, ch. 2100, p. 110. "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned."¹ One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.² Here, the Examiner has not established at least two of the three basic criteria for establishing a *prima facie* case of obviousness, and thus the rejection is improper and must be overturned.

Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not the

¹ In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

² In re Fine, 837 F.2d at 1075.

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In addition, as stated in MPEP 2143.01, "[I]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In the Office Action, the Examiner indicated that Oliver disclosed the use of hollow metal tubes in handles, and further that Harmala et al. disclosed the use of reinforcing inserts used to strengthen the handle. A closer inspection of Harmala, however, reveals that only one insert (the inner shaft 32) is contemplated in the specification. The use of multiple inserts is therefore not contemplated by the combination of cited references, which is the third of the three basic criteria under Section 2143 of the Manual of Patent Examining required for establishing a *prima facie* case of obviousness, namely that the prior art reference (or references when combined) must teach all of the claim limitations. Because the combination of references does not teach multiple inserts as in claims 35-48, the Examiner has failed to establish a *prima facie* case of obviousness, thus the rejection of claims 35-48 is improper per In re Ochiai and In re Fine. As such, reconsideration of claims 35-48 is thus respectfully requested.

Moreover, because the Examiner has failed to establish a *prima facie* case of obviousness, the Applicants are under no obligation to submit evidence of nonobviousness. However, each of the independent claims 35, 40 and 45 provides advantages over the prior art that were discussed and provide evidence of nonobviousness. For example, each of claims 35-48 notes that the offsetting of the reinforcing inserts from the intermediate portion of the tube minimizes the weight of the handle. Further, claim 35 notes that the reinforcing inserts strengthen the tube at the top end (that attaches to the lacrosse head) and counterbalance the lacrosse handle at the bottom end, while claim 45 notes that the reinforcing inserts prevent local deformation of the lacrosse handle.

In addition, Oliver and Harmala are both directed towards ski poles, not lacrosse handles. The function of the reinforcing insert introduced along the entire length of a ski pole is different than the function of introducing a pair of reinforcing inserts at the top and bottom end of a lacrosse handle. As stated in Harmala, the function of the reinforcing insert introduced along the entire length of a ski pole is directed towards strengthening the ski pole and allowing the ski pole to absorb significant bending loads during a fall or other use, while the reinforcing inserts of the present invention, the offsetting of the pair of reinforcing inserts would provide an area of decreased strength between the two ends of a ski pole that would be prone to bend and break during significant bending loads. Thus, even if the combination of the admitted prior art and Oliver and Harmala did teach what is claimed in claims 35-48 of the present invention, which Applicants do not believe, the Applicants are of the belief that there would be no motivation to combine the references as the Examiner proposes to arrive at the present invention, nor any reasonable expectation of success in combining the references.

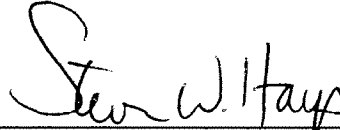
By the foregoing amendment, the Applicants have added new claims 49-51. Each of these new claims 49-51 is directed towards a lacrosse stick having a lacrosse head that is coupled to the top end of a lacrosse handle having a pair of reinforcing inserts of independent claims 35, 40 and 45. It is respectfully submitted that these new claims meet the requirements of patentability over the cited prior art. Consideration of new claims 49-51 is respectfully requested.

It is submitted that all objections and rejections of record have been overcome and that all pending claims are in condition for allowance. A notice of allowance is therefore earnestly solicited.

The Examiner is invited to telephone the Applicants' undersigned attorney at (248) 433-7245, if any unresolved matters remain. A Petition for a Three (3) Month Extension of Time accompanies this paper.

Respectfully submitted,

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